

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Wong et al.

Application Serial No.: 10/519,278

Filing Date: December 22, 2004

For: **AUTOMATED SENDING OF PRECONFIGURED MESSAGES**

Confirmation No. 8905

Group Art Unit: 2617

Examiner: Brandon J. Miller

May 13, 2008

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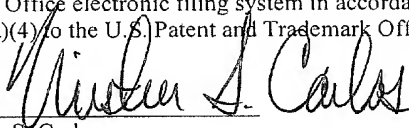
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Kirsten S. Carlos

APPELLANTS' BRIEF ON APPEAL

UNDER 37 C.F.R. §41.37

Sir:

This Appeal Brief is filed pursuant to the "Notice of Appeal to the Board of Patent Appeals and Interferences" filed February 28, 2008 and the "Notice of Panel Decision from Pre-Appeal Brief Review" mailed on April 14, 2008.

Real Party In Interest

The real party in interest is assignee Sony Ericsson Mobile Communications AB, Lund, Sweden.

Related Appeals and Interferences

Appellants are aware of no appeals or interferences that would be affected by the present appeal.

Status of Claims

Appellant appeals the final rejection of Claims 1, 4 – 12, and 15 - 24 as set forth in the final Office Action mailed November 28, 2007 (hereinafter "Final Action"), which as of the filing date of this Brief remain under consideration. Claims 1, 4 – 12, and 15 - 24 stand rejected. Appellants submit that the claims involved in the appeal are independent Claims 1, 12, and 24 and the rejected dependent Claims 4 – 11 and 15 - 23 as a reversal of the rejection of independent Claims 1, 12, and 24 is requested in the present appeal and a reversal of the rejection of dependent Claims 4 – 11 and 15 - 23 is also requested based, at least, on the reversal of the rejection of the independent claims. The claims at issue as included in Appellant's response to the Office Action of July 19, 2007 are attached hereto as Appendix A.

Status of Amendments

No amendments after final rejection have been filed in the present case.

Summary of Claimed Subject Matter

Independent Claim 1 is directed to a method of automatically sending electronic messages from a portable communication device to a selected recipient, including retrieving date information from an electronic date determination unit (Specification, page 7, lines 36 – 37; FIG. 5, block 40), retrieving first recipient related information from an electronic contact register, the first recipient related information being personal date information associated with the recipient (Specification, page 7, line 38 – page 8, line 7; FIG. 5, blocks 44 and 46), and automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the first recipient related information (Specification, page 8, lines 6 – 15; FIG. 5, blocks 46 and 48).

Independent Claim 12 is directed to a portable communication device for automatically sending electronic messages to a selected recipient including an electronic date determination unit (Specification, page 7, lines 8 – 10; system clock 27 of FIG. 4), an electronic contact register (Specification, page 7, lines 16 – 18; contacts unit 38 of FIG. 4), a message transfer unit (Specification, page 7, lines 13 – 15; message transfer unit 32 of FIG. 4), a pre-configured message store (Specification,

page 7, lines 13 – 15; message store 30 of FIG. 4), and a control unit (Specification, page 7, lines 13 – 15; control unit 28) configured to retrieve date information from the electronic data determination unit and first recipient related information relating to a recipient from the electronic contact register and effectuate automatic sending of a pre-configured electronic message to the recipient based on the date information and the first recipient related information, wherein the first recipient related information is personal date information associated with the recipient (Specification, page 7, line 36 – page 8, line 15; FIG. 5).

Independent Claim 24 is directed to a computer program product stored on a computer readable medium (Specification, page 9, lines 31 – 34) including computer readable program code configured to retrieve date information from an electronic date determination unit (Specification, page 7, lines 36 – 37; FIG. 5, block 40), computer readable program code configured to retrieve recipient related information from an electronic contact register, the recipient related information being personal date information associated with the recipient (Specification, page 7, line 38 – page 8, line 7; FIG. 5, blocks 44 and 46), and computer readable program code configured to effectuate automatic sending of a pre-configured electronic message over a network to the recipient based on the date information and the recipient related information (Specification, page 8, lines 6 – 15; FIG. 5, blocks 46 and 48).

Grounds of Rejection to be Reviewed on Appeal

Claims 1, 4, 5, 8, 9, 11, 12, 15, 16, 19, 20, and 22 - 24. stand rejected under 35 U.S.C. §103(a) as being unpatentable over U. S. Patent No.6,044,275 to Boltz et al. (hereinafter "Boltz") in view of U. S. Patent Publication No. 2003/0023759 to Littleton et al. (hereinafter "Littleton"). (Final Action, page 2).

Claims 6, 7, 17, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Boltz in view of Littleton and U. S. Patent Publication No. 2001/0021649 to Kinnunen et al. (hereinafter "Kinnunen"). (Final Action, page 7).

Claims 10 and 21 stand rejected under U.S.C. §103(a) as being unpatentable over Boltz in view of Littleton and U. S. Patent No. 6,625,460 to Patil (hereinafter "Patil"). (Final Action, page 8).

Argument

II. Introduction to 35 U.S.C. §103 Analysis

A determination under §103 that an invention would have been obvious to someone of ordinary skill in the art is a conclusion of law based on fact. *Panduit Corp. v. Dennison Mfg. Co.* 810 F.2d 1593, 1 U.S.P.Q.2d 1593 (Fed. Cir. 1987), *cert. denied*, 107 S.Ct. 2187. After the involved facts are determined, the decision maker must then make the legal determination of whether the claimed invention as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was unknown, and just before it was made. *Id.* at 1596. The United States Patent and Trademark Office (USPTO) has the initial burden under §103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988).

To establish a *prima facie* case of obviousness, the prior art reference or references when combined must teach or suggest all the recitations of the claims, and there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. M.P.E.P. §2143. A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l Co. v. Teleflex Inc.*, 550 U. S. 1, 15 (2007). A corollary principle is that, when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be unobvious. *Id.* at 12. If a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Id.* at 13. A Court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. *Id.* at 13. When it is necessary for a Court to look at interrelated teachings of multiple patents, the Court must determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. *Id.* at 14.

Appellants respectfully submit that the pending claims are patentable over the cited references for at least the reason that the cited references do not disclose or suggest, at least, all of the recitations of the pending independent claims. The patentability of the pending claims is discussed in detail hereinafter.

A. Independent Claims 1, 12, and 24 are Patentable

Independent Claims 1, 12 and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Boltz in view of Littleton. Independent Claim 1 is directed to a method of automatically sending electronic messages from a portable communication device to a selected recipient and recites, in part:

retrieving date information from an electronic date determination unit;
retrieving first recipient related information from an electronic contact register, the first recipient related information being personal date information associated with the recipient; and
automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the first recipient related information. (Emphasis added).

Independent Claims 12 and 24 include similar recitations. According to the independent claims, personal date information is associated with a recipient. A pre-configured electronic message is automatically sent over a network based on date information retrieved from an electronic date determination unit and the personal date information associated with the recipient. Some embodiments of the present invention may allow more simplified sending of personal messages, such as birthday greetings, to specific recipients. For example, in the case of a birthday greeting, a device user may include birthday information along with other contact information for one or more individuals in a contact register of a portable communication device. The user may also prepare a message to wish a particular individual a happy birthday. Once the communication device determines that there is a match between the current date and the birthday of the particular individual whose contact information is in the contact register, the communication device automatically sends the already prepared birthday message to the particular individual on his/her birthday.

The Final Action acknowledges that Boltz does not disclose or suggest "an electronic contact register and first recipient related information being personal date information." (Final Action, pages 2 and 3). The Final Action maintains, however, that Littleton provides the missing teachings. (Final Action, page 3). Appellants respectfully submit that neither Boltz nor Littleton disclose or suggest, at least, associating personal date information with a recipient and storing the personal date information in a contact register and also sending a pre-configured electronic message to the recipient based on the personal date information and date information retrieved from an electronic date determination unit.

Turning first to Boltz, this reference describes a system in which a user, *i.e.*, message sender, can define a date and time that an SMS message is to be delivered (Boltz, col. 4, lines 20 - 24; col. 4, lines 44 - 62; and col. 4, line 63 - col. 5, line 12). Boltz does not disclose or suggest associating personal date information with a recipient and storing the personal date information in a contact register. While Boltz does describe automatically sending an electronic message at a time defined by a user/sender, Boltz does not describe sending the electronic message based on personal date information associated with the recipient.

Turning next to Littleton, this reference describes a technique for provisioning telephony services on a personal digital assistant (PDA) in which a user is presented with a list of names of contacts in an address book database. The user may then select a contact from the database. (Littleton, paragraph 20). Once a user has selected a contact, various telephone service features can be selected for the contact, such as call waiting, call forwarding, call blocking, etc. (Littleton, paragraph 20). Littleton points out that a record for a contact in the database may include custom fields, such as a field for storing birthday information. (Littleton, paragraph 21). Such a custom field may be used to store a compressed coded string message representing the various telephony feature information associated with the contact. (Littleton, paragraph 23). Thus, Littleton does not disclose or suggest using personal date information as a basis for sending an electronic message. In fact, Littleton suggests using a field that may be used to store personal date information, such as birthday information, for another purpose, *i.e.*, to store telephony service feature information. If any birthday

information is stored in such a field, it appears that Littleton suggests replacing it with telephony service feature information.

In response to this argument, the Final Action states Appellants cannot show nonobviousness by attacking the references individually when the rejections are based on combinations of references. (Final Action, page 9). Appellants submit, however, that even if combined, the combination of Boltz and Littleton does not disclose all of the recitations of the pending independent claims. As discussed above, Boltz fails to disclose or suggest sending an electronic message based on personal date information associated with a recipient. If Boltz is modified to include the teachings of Littleton, then Boltz may include a contact database in which a record for a contact in the database includes a custom field, such as a field for storing birthday information. The custom field may be used to store a coded message that represents telephony feature information associated with the contact. There is no suggestion in Littleton that the custom field may instead be used to hold the birthday information and then that birthday information be used as a basis for sending an electronic message. Rather, Littleton teaches away from using the custom field for holding personal date information and recommends instead using the custom field to store telephony service feature information.

Accordingly, storing birthday information in the custom field would destroy the intent, purpose, and function of the telephony system of Littleton. When a §103 rejection is based on a modification of a reference that destroys the intent, purpose, or function of the invention disclosed therein, such a proposed modification is not proper and the prima facie case of obviousness cannot be properly made. In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Appellants submit, therefore, that the Boltz and Littleton references, either alone or in combination, do not disclose or suggest, at least, associating personal date information with a recipient and storing the personal date information in a contact register and also sending a pre-configured electronic message to the recipient based on the personal date information and date information retrieved from an electronic date determination unit as recited in independent Claims 1, 12, and 24.

For at least the foregoing reasons, Appellants respectfully submit that independent Claims 1, 12, and 24 are patentable over the cited references and that dependent Claims 4 - 11 and 15 - 23 are patentable at least by virtue of their depending from an allowable claim. Accordingly, Appellants respectfully request that the rejection of Claims 1, 4 - 12, and 15 - 24 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103.

B. Dependent Claims 6, 7, 17, and 18 are Patentable

Dependent Claims 6, 7, 17, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Boltz in view of Littleton and Kinnunen. (Final Action, page 7). Dependent Claims 6, 7, 17, and 18 depend from independent Claims 1 and 12, which Appellants submit are patentable for at least the reasons discussed above in Section IA. Appellant submits that dependent Claims 6, 7, 17, and 18 are patentable over the cited references at least by virtue of their depending an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellants respectfully request that the rejection of Claims 6, 7, 17, and 18 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103.

C. Dependent Claims 10 and 21 are Patentable

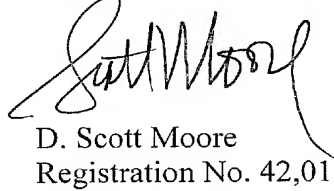
Dependent Claims 10 and 21 stand rejected under U.S.C. §103(a) as being unpatentable over Boltz in view of Littleton and Patil. (Final Action, page 8). Dependent Claims 10 and 21 depend from independent Claims 1 and 12, respectively, which Appellants submit are patentable for at least the reasons discussed above in Section IA. Appellants submit that dependent Claims 10 and 21 are patentable over the cited references at least by virtue of their depending an allowable claim. *Ex parte Ligh*, 159 U.S.P.Q. (BNA) 61, 62 (Bd. App. 1967). Accordingly, Appellants respectfully request that the rejection of Claims 10 and 21 be reversed based on the failure of the Examiner to establish a prima facie case of obviousness under 35 U.S.C. §103 for at least these reasons.

In re: Wong et al.
Application Serial No.: 10/519,278
Filing Date: December 22, 2004
Page 9

II. Conclusion

In summary, Appellants respectfully submit that, with respect to Claims 1, 4 – 12, and 15 - 24 the cited references do not teach all of the recitations of the claims. Accordingly, Appellants respectfully request reversal of the rejection of Claims 1, 4 – 12, and 15 - 24 based on the cited reference.

Respectfully submitted,



D. Scott Moore
Registration No. 42,011

USPTO Customer No. 54414
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

APPENDIX A

1. (Previously presented) A method of automatically sending electronic messages from a portable communication device to a selected recipient, comprising:

retrieving date information from an electronic date determination unit;
retrieving first recipient related information from an electronic contact register, the first recipient related information being personal date information associated with the recipient; and

automatically sending a pre-configured electronic message over a network to the recipient based on the date information and the first recipient related information.

4. (Previously presented) The method according to claim 1, further comprising:

retrieving second recipient related information from the electronic contact register; and

automatically sending the pre-configured electronic message over the network to the recipient based on the second recipient related information.

5. (Previously presented) The method according to claim 4, wherein the second recipient related information is a message flag.

6. (Previously presented) The method according to claim 1, further comprising:

prompting a user, after retrieving date and recipient related information, about sending the message; and

sending the message if the user has accepted sending.

7. (Previously presented) The method according to claim 1, further comprising:

retrieving a name of the recipient from the contact register; and
inserting the name into the message prior to sending.

8. (Previously presented) The method according to claim 1, wherein the message is sent directly to a terminal of the recipient.

9. (Previously presented) The method according to claim 1, wherein the message is sent to a remote server, which pushes it to a terminal of the recipient.

10. (Previously presented) The method according to claim 1, wherein contact information about a recipient is first received from a remote server and then placed in the contact register.

11. (Previously presented) The method according to claim 1, wherein the contact register is a register containing previously stored information about contacts and how these can be reached.

12. (Previously presented) A portable communication device for automatically sending electronic messages to a selected recipient comprising:
an electronic date determination unit;
an electronic contact register;
a message transfer unit;
a pre-configured message store; and
a control unit configured to retrieve date information from the electronic data determination unit and first recipient related information relating to a recipient from the electronic contact register and effectuate automatic sending of a pre-configured electronic message to the recipient based on the date information and the first recipient related information;

wherein the first recipient related information is personal date information associated with the recipient.

15. (Previously presented) A portable communication device according to claim 12, wherein the control unit is further configured to retrieve second recipient related information from the electronic contact register and effectuate sending of the message based on the second recipient related information.

16. (Previously presented) A portable communication device according to claim 15, wherein the second recipient related information is a message flag.

17. (Previously presented) A portable communication device according to claim 12, wherein the control unit after retrieving date and recipient related information is further configured to prompt a user about sending the message and effectuate sending of the message if the user has accepted sending.

18. (Previously presented) A portable communication device according to claim 12, wherein the control unit is further configured to retrieve the name of the recipient from the contact register and to insert the name into the message prior to sending.

19. (Previously presented) A portable communication device according to claim 12, wherein the control unit effectuates sending of the message directly to a terminal of the recipient.

20. (Previously presented) A portable communication device according to claim 12, wherein the control unit effectuates sending of the message to a remote server, which pushes it to the recipient.

21. (Previously presented) A portable communication device according to claim 12, wherein the message transfer unit receives contact information about a recipient from a remote server and the control unit is further configured to place this information in the contact register.

22. (Previously presented) A portable communication device according to claim 12, wherein the device is a cellular phone.

23. (Previously presented) A portable communication device according to claim 12, wherein the contact register is a register containing previously stored information about contacts and how these can be reached.

24. (Previously presented) A computer program product stored on a computer readable medium comprising:

computer readable program code configured to retrieve date information from an electronic date determination unit;

computer readable program code configured to retrieve recipient related information from an electronic contact register, the recipient related information being personal date information associated with the recipient; and

computer readable program code configured to effectuate automatic sending of a pre-configured electronic message over a network to the recipient based on the date information and the recipient related information.

In re: Wong et al.
Application Serial No.: 10/519,278
Filing Date: December 22, 2004
Page 14

APPENDIX B – EVIDENCE APPENDIX

None.

In re: Wong et al.
Application Serial No.: 10/519,278
Filing Date: December 22, 2004
Page 15

APPENDIX C – RELATED PROCEEDINGS APPENDIX

None.